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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,239	12/09/2003	Kevin L. Bostrom	LUC-442/Bostrom 5-6-11	4882

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CARMEN B. PATTI & ASSOCIATES, LLC  
ONE NORTH LASALLE STREET  
44TH FLOOR  
CHICAGO, IL 60602

EXAMINER
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LEE, JOHN J

ART UNIT	PAPER NUMBER
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2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/731,239

Applicant(s)

BOSTROM ET AL.

Examiner

JOHN J. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-13 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-13 and 16-28 is/are allowed.
- 6) ☒ Claim(s) 29 is/are rejected.
- 7) ☒ Claim(s) 30 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/23/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments with respect to claim 29 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 29** is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamek et al. (US 2002/0176559) in view of Boies et al. (US 2002/0191775).

Regarding **claim 29**, Adamek teaches that a method of placing on hold a phone call associated with a mobile phone (102 in Fig. 1) (page 1, paragraphs 5 – 11 and Fig. 1, where teaches supplying multimedia data by multimedia providing networks to callers (mobile terminals) whose interactive calls (voice calls, video calls) are placed on hold, and while on hold, a multimedia communication is sent to user terminal, and an invitation is sent to the user terminal to accept the multimedia communication while on hold).

Adamek teaches that searching, via an interactive server component (multimedia communications system in Fig. 1), a database (160 in Fig. 1) to determine one or more video preferences (the multimedia providers provide the proper multimedia service, video/audio, to the each wireless terminal) of user of the mobile phone (102 in Fig. 1) (page 1, paragraphs 5 – 11 and Fig. 1, where teaches supplying proper multimedia data for each mobile user from multimedia providing networks to callers (mobile terminals)

by the query message that interactive calls (voice calls, video calls) are placed on hold, and while on hold, a multimedia communication is sent to user terminal, and an invitation (query message) is sent to the user terminal to accept (permission) the multimedia communication while on hold). Adamek teaches that employing at least one of the one or more video preferences, via a video server component (multimedia communications system in Fig. 1), to play a video from a plurality of videos selected by the user via the mobile phone (102 in Fig. 1) to play at the mobile phone while the phone call associated with the mobile phone is on hold (page 1, paragraphs 5 – 11, Fig. 1, and pages 2, paragraphs 17 – 21, where teaches supplying providing the proper multimedia data (audio, video, data) to each mobile station from multimedia providing server to users (mobile terminals) whose interactive calls (voice calls, video calls) are placed on hold, and while on hold, the proper multimedia service communication is sent to user terminal, and an invitation (query message) is sent to the user terminal to accept (permission for selected multimedia, video, data) the multimedia communication while on hold).

Adamek does not specifically disclose the limitation “a database to determine one or more video preferences”. However, Boies supportly teaches the limitation “a database to determine one or more video preferences” (page 1, paragraphs 6 and Fig. 2, where teaches a database of customized information content is consulted and information content (video) is selected according to user’s identity). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Adamek system as taught by Boies, provide the motivation to enhance providing the desired multimedia signal to each mobile terminal in mobile communication system.

*Allowable Subject Matter*

4. Claims 4-13 and 16-28 are allowed.

Claims 4-13 and 16-28 are allowable over the prior art of record because a search does not detect the combined claimed elements as set forth in the claims 4-13 and 16-28.

As recited in independent claims 4, 6, 16, 17, 20, and 22, none of the prior art of record teaches or fairly suggests that the query message comprises a choice between the first video and a second video, wherein the first video is stored at the first internet protocol address and the second video is stored at a second internet protocol address, and a user of the mobile phone employs the mobile phone to reply to the choice with a selection of the first video or the second video, wherein the mobile phone sends the selection to the video server component, and wherein the video server component employs the selection to connect the mobile phone to the first internet protocol address for the first video or the second internet protocol address for the second video, and also the interactive server component searches a database with the user information to make a determination of one or more user preferences of a user of the mobile phone, and the interactive server component passes the one or more user preferences to the video server component, and together with combination of other element as set forth in the claims 4-13 and 16-28. Therefore, claims 4-13 and 16-28 are allowable over the prior art of records.

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5. Claims 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to disclose “sending a query message to the mobile phone for permission to play the video at the mobile phone, wherein the query message comprises a choice between the first video and a second video, and wherein the first video is stored at a first Internet protocol address and the second video is stored at a second Internet protocol address, and receiving a reply from a user of the mobile phone with selection of the first video or the second video, employing the selection of the first video or second video to connect the mobile phone to the first Internet protocol address for the first video or second video Internet address for the second video, taking the phone call associated with the mobile phone off hold when an intended recipient becomes available” as specified in the above the claims.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### *Conclusion*

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
Or P.O. Box 1450  
Alexandria VA 22313

or faxed (571) 273-8300, (for formal communications intended for entry)

Or: (703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to USPTO Headquarters,  
Alexandria, VA.

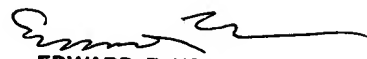
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is (571) 272-7880. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Edward Urban**, can be reached on (571) 272-7899. Any inquiry of a general nature or

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relating to the status of this application should be directed to the Group receptionist  
whose telephone number is (703) 305-4700.

J.L  
April 13, 2007

John J Lee

  
EDWARD F. URBAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600